

Reply to Office Action

Application No. 10/811,469

## REMARKS

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*Discussion of Claim Amendment*

Claim 10 has been canceled without prejudice and new claim 12 has been added, which is directed to a method of preparing a positive working heat-sensitive lithographic printing plate precursor. No new matter has been added.

*Discussion of Rejections*

The Office Action rejects claims 1-7, 10, and 11 under 35 U.S.C. §103(a) as allegedly unpatentable over Verschueren et al. (EP 0 950 516 A1); and claims 8 and 9 under 35 U.S.C. §103(a) as allegedly unpatentable over Verschueren et al. in view of specification page 4, lines 31-33. Applicants respectfully transverse the rejections.

The present Office Action has maintained the grounds of rejection set forth in the Office Action of April 19, 2005. In the reply filed on July 19, 2005, applicants pointed to the unexpected results associated with the presently claimed invention, particularly the recited particle size. The present Office Action states that it disagrees with the applicants' position that the results of using particles having a size range of 1-7  $\mu\text{m}$  are unexpectedly superior in terms of the scuff-mark resistance of the printing plate precursor. The Office Action states that present Example 9 (which uses P-05 particles of 6  $\mu\text{m}$  size) does not show unexpected superior results when compared comparative Example 2 (which uses CP-01 particles of 0.5  $\mu\text{m}$  size). The Office Action points to the rating of "3" for Example 9 and the rating of "4" for comparative Example 2. The Office Action states that "even applicants call the rating of "4" as a **relatively unacceptable result.**"

Applicants respectfully disagree with the Office's reading of the applicants' remarks and the presently claimed invention, for the following reasons.

The application at page 27, lines 8-17 clearly defines the four rating levels for the scuff-mark resistance wherein the difference between rating 3 and rating 4 depends on the number and/or the size of the destructions present on the plate. Rating 3 means that the number and size of the destructions are sufficiently low and therefore "still acceptable for a printing plate." In rating 4, a high number and/or a large size of the destructions are present and therefore "unacceptable for a printing plate application." Thus, there is an important

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difference between rating 3 and rating 4. The Office has failed to see this important difference. The Office fails to see the forest for the trees. The Office erroneously focuses on a single word in the argument ("relatively") and draws an inaccurate conclusion. The term "relatively" should be interpreted, as would be clear to those skilled in the art in light of the disclosure as discussed above, by the relative number of the destructions (low-high) and/or the relative size of the destructions (small-large); the subject term has nothing to do with a reduced difference between these two ratings as the Office appears to argue.

Further, the "unexpected superior result" of the claimed invention is clearly demonstrated by a second series of experiments in Table 2: Example 14 (which uses P-05 particles, 6  $\mu\text{m}$ ) exhibited a rating "2" in comparison with rating "4" for Comparative Example 14 (using CP-01 particles, 0.5  $\mu\text{m}$ ); see specification, page 29, line 10 to page 30, line 6. In addition, as set forth in Table 1, Examples 1-9 and Table 2, Examples 10-13, embodiments of the claimed invention have acceptable ratings of 1, 2, or 3, which are excellent, good, or fair. The unexpected superior results of the presently claimed invention are demonstrated by the entire set of the examples. The Office must consider all the evidence provided, not selected ones.

Applicants have shown ample and objective evidence of unexpectedly superior results. Applicants also have shown that the difference in the results obtained are of practical significance, i.e., a rating of "4" of the prior art product is unacceptable in contrast to a rating of 1, 2, or 3, of the presently claimed invention, all of which are acceptable to prepare printing plates. The specification also includes explicit support for the unexpected results in the specification.

The foregoing clearly shows that applicants have more than met the requirements of Section 103(a). Accordingly, the rejection should be withdrawn. New claim 12 also should not be rejected on this basis.

*Conclusion*

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

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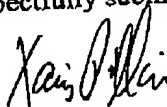
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Respectfully submitted,



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